

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF TEXAS  
WACO DIVISION

FORUM US, INC.

Plaintiff,

v.

ODESSA SEPARATOR, INC.

Defendant.

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Case No. 6:20-CV-00150-ADA

**DECLARATION OF JEFFREY A. TINKER**

I, Jeffrey A. Tinker, subject to the laws concerning perjury, hereby submit this Declaration pursuant to 28 U.S.C. § 1746 and state as follows:

1. My name is Jeffrey A. Tinker. I am over 18 years of age, of sound mind, and competent in all respects to make this Declaration. I have personal knowledge, or knowledge based on my review of records that are within my custody and control, of all the matters stated herein, and they are all true and correct.

2. I am one of the attorneys representing Defendant Odessa Separator, Inc. in the above-referenced matter. During the course of litigation in the above-referenced matter, I obtained and discovered information in connection with this lawsuit. Accordingly, I have learned of and became aware of the following documents in my role as counsel for Defendant in the above-referenced matter.

3. Attached hereto as Exhibit 6 is a true and correct copy of page 5 of the Amendment After Final filed by the applicant on September 27, 2018, during prosecution of the Application Serial No. 15/229,369, the application that issued as Patent 10,132,151.

4. Attached hereto as Exhibit 7 is a true and correct copy of the Notice of Allowability that was sent to the applicant on October 12, 2018, during prosecution of the Application Serial No. 15/229,369, the application that issued as Patent 10,132,151.

5. I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct and that this declaration was executed on the 2nd day of October, 2020, in Dallas, Texas.

/s/ Jeffrey A. Tinker

Jeffrey A. Tinker

## Exhibit 6

23. (Previously Presented) A hydrocarbon production system comprising:  
a production tubing; and  
a downhole apparatus according to claim 20 coupled into the production tubing;  
wherein the downhole pump is coupled to the production tubing below the downhole apparatus.

24. Cancelled.

25. (Currently Amended) A method of operating a hydrocarbon production system comprising a production tubular, a downhole pump in the production tubular, and a downhole apparatus coupled to the production tubular above the downhole pump, the method comprising:  
in a production phase, operating the downhole pump to cause fluid to flow in a first flow path upward through the downhole apparatus;  
ceasing operation of the downhole pump;  
~~diverting~~directing downward flow of fluid and/or downward-moving solids to a second flow path in the downhole apparatus;  
filtering or collecting solid particles moving downwardly in the second flow path;  
operating the downhole pump to cause production to flow upwardly in the first flow path and to induce upward flow in the second flow path via at least one or more vents arranged between a lower part of the first flow path and a lower part of the second flow path, such that the induced upward flow washes away solids from a lower part of the second flow path.

26. (Previously Presented) The method as claimed in claim 25, further comprising carrying filtered or collected solid particles out of an upper opening of the downhole apparatus.

27. (Currently Amended) The method as claimed in claim 25, comprising directing flow towards a lower surface of a volume of solids collected in the downhole apparatus through one or more holes arranged between a lower part of the first flow path and in a bottom surface of ~~in a bottom surface of~~ the second flow path.

28. Cancelled.

## Exhibit 7

**Notice of Allowability****Application No.**

15/229,369

**Applicant(s)**

LEITCH, ANDREW

**Examiner**

MICHAEL R WILLS III

**Art Unit**

3676

**AIA Status**

No

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Request for Continued Examination filed September 25, 2018.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on \_\_\_\_\_.

2. ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_\_; the restriction requirement and election have been incorporated into this action.

3. ☒ The allowed claim(s) is/are See Continuation Sheet. As a result of the allowed claim(s), you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see [http://www.uspto.gov/patents/init\\_events/pph/index.jsp](http://www.uspto.gov/patents/init_events/pph/index.jsp) or send an inquiry to [PPHfeedback@uspto.gov](mailto:PPHfeedback@uspto.gov).

4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

**Certified copies:**

a) ☒ All      b) ☐ Some      \*c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☒ Certified copies of the priority documents have been received in Application No. 13996769.

3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file areply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.

☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

**Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)

5. ☒ Examiner's Amendment/Comment

2. ☐ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_.

6. ☒ Examiner's Statement of Reasons for Allowance

3. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material \_\_\_\_\_.

7. ☐ Other \_\_\_\_\_.

4. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.

/MICHAEL R WILLS III/  
Primary Examiner, Art Unit 3676

Continuation of 3. The allowed claim(s) is/are: 1-2,5-14,16-17,19-21,23,25-27 and 31-47

***EXAMINER'S AMENDMENT***

***Notice of Pre-AIA or AIA Status***

1. The present application is being examined under the pre-AIA first to invent provisions.
2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in an interview with John Eisenhart on September 27, 2018.

The application has been amended as follows:

3. 23. (Previously Presented) A hydrocarbon production system comprising: a production tubular ~~tubing~~; and a downhole apparatus according to claim 20 coupled into the production tubing; wherein the downhole pump is coupled to the production tubular ~~tubing~~ below the downhole apparatus.

***Reasons for Allowance***

4. The following is an examiner's statement of reasons for allowance: Applicant is claiming a downhole apparatus that has a body configured to be coupled to a production tubular or tubing and an upper opening and a lower opening. First and second flow paths are provided between the upper opening and the lower opening in the body, and a flow diverter is arranged to direct downward flow through the body towards the second flow path and away from the first flow path. A filter device in the second flow path filters or collects solid particles in the second flow

Art Unit: 3676

path from passing out of the lower opening of the apparatus. Applicant amended the independent claim 25 stating the solids are diverted to a second flow path in the downhole apparatus.

Additionally, applicant amended independent claim 46 stating washing away solids that have previously been diverted to the second flow path. The closest art was Yang CN 1955438 A (Yang). However, Yang does not teach diverting fluid to a second flow path or washing away solids that have previously been diverted to the second flow path as taught by independent claims 25 and 46. Furthermore, Yang does not teach a flow diverter as claimed in independent claims 1 and 20. For these reasons, this application is in a condition for allowance.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***Continued Examination Under 37 CFR 1.114***

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 25, 2018 has been entered.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R WILLS III whose telephone number is (571)272-5521. The examiner can normally be reached on Monday-Friday 8:30am to 5:00pm.